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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:	)	
<b>Jay Paul Drummond, et al.</b>	)	
	)	
Serial No.: <b>09/193,791</b>	)	Art Unit: <b>3624</b>
	)	
Confirmation No.: <b>2451</b>	)	
	)	
Filed: <b>November 17, 1998</b>	)	Patent Examiner:
	)	<b>James S. Bergin</b>
Title: <b>Automated Banking Machine</b>	)	
<b>Apparatus and System</b>	)	

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Alexandria, VA 22313-1450

**SUPPLEMENTAL BRIEF OF APPELLANTS  
PURSUANT TO 37 C.F.R. § 1.192**

Sir:

The Appellants hereby request reinstatement of the appeal pursuant to 37 C.F.R. § 1.193(b)(2). The Appellants hereby submit their Supplemental Appeal Brief pursuant to 37 C.F.R. § 1.192, in triplicate, concerning the above-referenced Application.

## **REAL PARTY IN INTEREST**

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

## **RELATED APPEALS AND INTERFERENCES**

Appellants believe that there are no related appeals or interferences pertaining to this matter.

## **STATUS OF CLAIMS**

Claims 1-20 are pending in the Application.

Claims 1-20 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over the Los Angeles Times article "Trade It Yourself Bank Machines Make A Debut" (hereinafter "LA Times") in view of the Infoworld article "TP-Monitor Vendors Spin Web Features" (hereinafter "Infoworld").

These rejections were the only rejections present in the Office Action ("Action") dated July 15, 2003. Appellants appeal each claim rejection, inclusive.

## **STATUS OF AMENDMENTS**

No final rejection is pending. However, claims have been rejected at least twice. Therefore, no amendments to the claims were requested to be admitted after a final rejection.

Appellants acknowledge the Office's admission that the Semple-based rejections and the U.S. Bancorp-based rejections have been withdrawn because of the arguments presented in the Appeal Brief filed May 3, 2002. As shown in more detail herein, Appellants' claims are also allowable over the current grounds of rejection. The Offices' withdrawal of all previous rejections is merely reflective of the impropriety of the currently pending rejections. Thus, Appellants respectfully request reinstatement of their appeal pursuant to 37 C.F.R. § 1.193(b)(2).

## **SUMMARY OF INVENTION**

### Overview of an exemplary form of the Invention

An exemplary form of the invention is directed to an apparatus including an ATM (12). The ATM includes a computer (34) in operative connection with an output device (e.g., a display device 30) and a currency sheet dispenser (42). Software is executable in the computer. The software includes a browser (76). During operation of the currency sheet dispenser (42) the software is operative to provide an output through the display device (30) responsive to an HTML document accessed by the browser. The HTML document includes instructions which are operative when processed by the browser, to both provide the output through the display device (30) and to cause the computer to operate the currency sheet dispenser (42) to dispense a currency sheet. The output through the display device, such as advertising, can be displayed while the customer is waiting for the currency sheet dispenser to operate.

The address of the HTML document that is accessed may be determined from input customer data, such as data read from a customer's card. A customer's card may include indicia which corresponds to a uniform resource locator ("URL") address associated with customer

information. The data necessary to derive the address for accessing documents associated with a customer could also be derived from other identifying inputs, such as biometric data input by a customer.

The customer information may include customer preference information. The accessed HTML document may include advertising or a customer message. The accessed document may also include instructions which cause the ATM to access or generate another document. These instructions may invoke features which depend on the information associated with the customer, the particular ATM, the current time, and/or other data or circumstances. It should be understood that in some embodiments these HTML documents may be accessed through the Internet. The apparatus makes it possible for operators of ATMs to present targeted advertising to individual customers. The advertising may even be selectively presented based on the particular customer, the particular transaction function device being used, the amount of funds involved, and/or other banking parameters.

## **CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW**

The questions presented in this appeal are whether Appellants' claims 1-20 are unpatentable under 35 U.S.C. § 103(a) over LA Times in view of Infoworld.

## **GROUPING OF CLAIMS**

No groups of claims stand or fall together. Each of Appellants' claims recites at least one element, combination of elements, or step not found or suggested in the applied references, which patentably distinguishes the claims.

Every claim recites additional features of the invention which distinguishes the claim over every other pending claim.

The pending claims include five independent claims (claims 1, 2, 4, 7, and 13). Claims 3 and 15 depend from claim 1. Claims 5-6 depend from claim 4. Claims 8-12 and 16-17 depend from claim 7. Claims 14 and 18-20 depend from claim 13. All pending claims are reproduced in the Appendix.

## **ARGUMENT**

### **The Applicable Legal Standards**

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142 (Eighth Edition, August 2001; Rev. 1, Feb. 2003).

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or

motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

A determination of patentability must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

#### **The LA Times Article**

The LA Times article is directed to Citibank using ATMs to offer brokerage services. Citibank uses a "specially designed" ATM that keeps the brokerage services "separate" from the banking services via different menus. One menu is for banking and another menu is for brokerage services. LA Times is silent as to the (small) number of ATMs capable of providing brokerage services. However, the system structure currently limits ATMs to only geographical locations in New York, Chicago, and Miami.

#### **The Infoworld Article**

The Infoworld article is directed to a TP monitor called "Top End." It is well known that a "TP" monitor is an abbreviation for a "transaction processing" monitor. A plethora of

information on TP monitors is available, including information which may be found via the Internet. A TP monitor is a program that monitors or tracks a transaction as it passes from one stage in a process to another, including across different computer systems. The TP monitor can provide transaction and data integrity by ensuring that each tracked transaction gets processed to completion or is otherwise completely rolled back. Thus, for example, a TP monitor can make sure that groups of updates that are supposed to take place together actually do all take place, or otherwise none take place. A TP monitor may also be useful in balancing system loads and in recovery from system failures. For example, a TP monitor may be used to monitor whether a message sent from a sending application program was successfully transmitted and received by a receiving application. In the event of a failure as determined by the TP monitor, the failed message can be either resent or switched over to a process on another node.

Infoworld teaches that Top End is "middleware" software that lets users deploy point-of-sale applications. Top End is apparently applicable to tracking transactions conducted using credit cards at ATMs and cash registers to be sure they are properly processed. A Web-specific version of Top End newly written at the time of the article has client code written as a set of Java class libraries. The Java client running in the cash register or ATM downloads the transaction data by establishing a direct link to a Web browser that runs at the Top End remote back-end system. The back-end system records and stores the data about the transactions. In this way, the client directly connects to the Top End back office (away from the ATM or cash register) through a (TCP/IP) connection. The Top End client can send transaction data from the cash register or ATM to the remote back-end system (which charges the customer's account for the transaction) to reduce the risk that the transaction is not properly processed.

**(iii) 35 U.S.C. § 103**

Appellants traverse the rejections on the grounds that Appellants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features and relationships recited in Appellants' claims patentably distinguish over the applied references.

Appellants respectfully submit that none of the applied references, taken alone or in combination, disclose or suggest the features and relationships that are specifically recited in the claims. Additionally, even if it were somehow possible for the references to have disclosed certain features as alleged, it still would not have been obvious to have combined the references as alleged. Furthermore, even if it were somehow possible for the references to be combined as alleged, the resultant combination still would not have produced Appellants' claimed invention. The Office has not established a *prima facie* showing of obviousness. Appellants respectfully submit the rejections are improper and should be withdrawn.

**The Claims Are Not Obvious Over  
LA Times in view of Infoworld**

Claims 1-20 were rejected under 35 U.S.C. § 103(a) over LA Times in view of Infoworld. These rejections are respectfully traversed.

**Claim 1**

Claim 1 is directed to an automated transaction machine comprising a computer in operative connection with an output device and a currency sheet dispenser, and software



executable in the computer. The software includes a browser. During operation of the currency sheet dispenser the software is operative to provide an output through the output device responsive to a document accessed by the browser. As discussed in more detail herein, neither LA Times nor Infoworld, taken alone or in combination, teach or suggest the features and relationships.

The Action (page 3) alleges that an ATM in LA Times "is considered to perform all the banking functions of a typical ATM, such as account access, transfer funds, dispense cash, dispense receipts, dispense statements, etc. The Citibank ATM is also considered to possess all the normal components and component interrelationships of an ATM machine such as a currency output device and a currency sheet dispenser, a receipt output device including a receipt sheet dispenser, etc., and a computer in operative connection with the output devices and the currency sheet dispensers." The Appellants respectfully disagree.

The banking functions in LA Times that the ATM is "considered to perform" and the components that the ATM is "considered to possess" are pure speculation by the Office. LA Times is silent as to the available banking functions and components included with the ATM. For example, where does LA Times specifically teach that the ATM is able to provide account access, transfer funds, and dispense statements, especially in 1994?

Appellants respectfully disagree that the alleged ATM components are inherent in LA Times. Anticipation by inherency requires that the Office establish that persons skilled in the art would recognize that the missing components are necessarily present in the LA Times reference. To establish inherency the Office must prove through citation to prior art that the features alleged to be inherent are "necessarily present" in LA Times. However, there is no teaching or

suggestion in LA Times that the ATM is able to provide account access, transfer funds, and dispense statements. Nor has the Office proved that every ATM is able to provide account access, transfer funds, and dispense statements. That is, the Office has not proved through citation to prior art that the alleged features are "necessarily present" in LA Times. Inherency may not be established based on probabilities or possibilities (which is the present situation). It is plainly improper to reject a claim based merely on the (speculative) possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Nor has the Action established in the prior art what constitutes the alleged "normal components" or "a typical ATM." Nor is there any teaching or suggestion that an ATM in LA Times is "a typical ATM", as alleged. Contrarily, LA Times specifically teaches that the ATM is "specially designed" (i.e., atypical). The limited locations (and thus quantity) of the ATMs also points to their uniqueness. Thus, in light of Appellants' contrary showing, the assertion that LA Times has "a typical ATM" with "normal components" is not legally appropriate.

The Action's assertions are not based on any evidence in the record. An assertion of prior art knowledge not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, supra. The determination of patentability must be based on evidence of record. *In re Lee*, supra. Appellants respectfully submit that because the rejection is based on mere assertions and not proper evidence of record, it is not a valid rejection.

The Action (on page 3, last paragraph) admits that LA Times does not teach or suggest the user interface at the ATM being a web browser interface. That is, the Action admits that LA

Times does not teach or suggest an ATM having a browser. The Appellants concur that LA Times does not teach or suggest an ATM having a browser.

LA Times also does not teach or suggest an ATM that is able to access a mark up language document with a browser. Nor is there any teaching or suggestion in LA Times that an ATM mentioned therein needs a browser or could even operate with a browser. Contrarily, the limited geographical locations of the ATMs in LA Times appear to point to the system as being locally based with conventional prior art communications and programming rather than Web-based. Furthermore, even if it were somehow possible for LA Times to include a browser that can access a document, there would still be no teaching or suggestion of software that is operative to provide an output through an automated transaction machine output device responsive to a document accessed by the browser, especially during operation of a currency sheet dispenser. Where does Infoworld relate or link an output of an automated transaction machine output device with currency sheet dispenser operation? Where does Infoworld coincide or overlap currency dispenser operation and output device operation?

The Action alleges (on page 4) that in Infoworld a "browser interface is the interface through which all the ATM banking functions of the NCR ATM machine are performed, such as account access, funds transfer, the dispensing of currency and receipts responsive to the interaction of the user with the web browser interface." The Appellants respectfully disagree.

Where does Infoworld teach or suggest such features? For example, where does Infoworld teach or suggest that all the ATM banking functions are performed through a browser interface? Where does Infoworld teach or suggest that Top End carries out and controls the ATM transactions? Rather, Infoworld, as best understood, is directed to a TP monitoring

program that monitors or tracks a transaction. Apparently, Top End (similar to present day TP monitors) ensures that each monitored transaction gets completed or rolled back. Note the above description of the Infoworld reference. Infoworld also admits that Web standards like CGI cannot handle Top End class applications (page 1, second to last paragraph).

Infoworld teaches that Top End is also applicable to cash registers in the same manner as it is applicable to ATMs. Where does Infoworld teach or suggest that Top End controls cash registers? If a cash register cannot be controlled by Top End then neither can an ATM.

Appellants respectfully submit that the Action takes the Infoworld language out of context. Infoworld does not state that it enables ATM transactions over the Web to make one or 10,000 machines look as if they are local to a computing resource, as alleged in the Action. Contrarily, Infoworld teaches that the "one or 10,000 machines" comment is directed to the Top End program reporting transactions to a back-end accounting system. Infoworld admits that NCR is still "trying to overcome" limitations "to enable" transactions over the Web. Thus, Infoworld is not capable of carrying out ATM transactions over the Web.

Furthermore, the system described in Infoworld describes credit card transactions being controlled and performed through a conventional proprietary banking network (without a browser), with the account balancing transfers being monitored and reported to a back office system. The browser resides remotely from the ATMs and cash registers at the back office system. Where does Infoworld teach that Top End requires use of a browser operating at an ATM or cash register?

Nor is there any teaching or suggestion in Infoworld of software that is operative to provide an output through an output device responsive to a document accessed by a browser,

especially during operation of a currency sheet dispenser. Where does Infoworld relate or link an output of an automated transaction machine output device with an accessed document? Where does Infoworld relate or link an output of an automated transaction machine output device with currency sheet dispenser operation? Where does Infoworld teach or suggest correlation between currency dispensing and outputting? Again, the Office wrongfully relies on pure speculation as the only basis for the allegations, instead of an actual teaching or suggestion in the applied reference. *In re Zurko*, supra.

The Action alleges that it would have been obvious in view of Infoworld to provide the LA Times ATM with a web browser interface. The reason provided in the Action is to enable the ATM user to perform all the typical ATM functions, including transactions over the Web and dispensing currency sheets through the output devices. Appellants respectfully submit that the relied upon reason is without merit because neither of the applied references teach, suggest, or provide motivation for enabling an ATM to perform ATM transactions over the Web, including transactions dispensing currency sheets, as alleged. As previously discussed, both references lack the ability to perform ATM transactions over the Web. The Action admits this deficiency in the LA Times article. As previously discussed, Infoworld is limited to credit card transaction monitoring, and is likewise applicable to monitoring cash register transactions. Again, neither of these references teach or suggest the alleged ability to perform ATM transactions (including dispensing currency) over the Web. It follows that the references combined also cannot teach or suggest the alleged ability. Furthermore, neither of the applied references even teach or suggest (or mention) an ATM having a currency sheet dispenser, as alleged.

The Action further relies on an unsupported allegation of Official notice regarding the "fact" that it is well known (in the art of sheet feeders) that documents which are processed by the controlling web browser interface of a "particular" sheet feeding machine contain instructions for controlling the output devices of the machine, such as dispense instructions for feeding sheets through the output devices of the machine. The Action further alleges that such an arrangement provides an effective and reliable control system for the output devices of the machine.

The Appellants respectfully disagree. First, claim 1 recites a "currency sheet dispenser" not a "sheet feeding machine" as alleged. Nevertheless, the Appellants continue to challenge the assertions of "Official notice." Where is the prior art teaching of the alleged "fact"? This Application claims priority back to November 27, 1996. Where is the evidence of record of the alleged prior art teaching of documents containing dispense instructions for feeding sheets through output devices of a machine, especially an automated transaction machine? The prior art evidence of record does not teach or suggest the recited features. The rejection relies on unsupported assertions and conclusory statements, not concrete evidence. The Action's mere assertions do not constitute the required prior art evidence of record to legally support the rejections, and thus the rejections lack substantial evidence support. The determination of patentability must be based on the evidence of record, not on unsubstantiated assertions under the guise of an Official notice (which is the present situation). It is respectfully submitted that the rejections are improper and that the claims should be allowed. *In re Zurko*, supra. *In re Lee*, supra. MPEP § 2144.03.

Furthermore, in order to establish *prima facie* obviousness it must be shown that all the elements and relationships recited in the claim are known in the prior art. As Appellants have

shown, the Office does not factually support any *prima facie* conclusion of obviousness. The Appellants are not required to prove patentability. On the contrary, it is the Office which must establish a *prima facie* case of obviousness under the law. Otherwise, in the absence of any other valid rejection (which is the present situation), the Office is legally required to issue a patent.

The Action (on page 5) still further relies on another allegation of "Official notice" asserting that it is "well known" that the documents (containing instructions) in the aforementioned allegation of Official notice are "often" HTML documents/pages. That is, the rejection relies on an unsupported allegation based on other unsupported allegations. However, as previously discussed, a valid rejection involving Official notice must be based on evidence of record. Where does the evidence of record relate an ATM output to a document that is accessed by a browser, especially where the output is provided during operation of a currency sheet dispenser? It does not. It follows that the rejection is not legally valid.

Claim 1 recites that during operation of the currency sheet dispenser the software is operative to provide an output through the output device responsive to a document accessed by the browser. The Action does not address the recited software features. The Action is silent as to any prior art teaching or suggestion whatsoever of automated transaction machine software with the capability to provide an output through an output device during operation of a currency sheet dispenser. Where in the cited references is any teaching, suggestion, or even a mention of providing output during a currency dispense? Appellants have shown that a *prima facie* case of obviousness has not been established because the relied upon references do not teach or suggest all of the claim features. The Office has not met the burden of establishing *prima facie* obviousness.

The Action is also silent as to how the system referred to in LA Times could be modified by the teachings of Infoworld to achieve the recited apparatus. Nor has any evidence been presented that LA Times is structurally and functionally capable of being modified by the teachings of Infoworld, especially to produce the recited invention. For example, the Action has not shown that NCR's ATM technology (Infoworld) is compatibly interchangeable with Citibank's ATM technology (LA Times). Nor has the Action presented a valid motivation to combine. Since the Action does not explain the rejection with reasonable specificity, it also procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989). Thus, it would not have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of Infoworld as alleged.

Furthermore, even if it were somehow possible to modify the system of LA Times with the teachings of Infoworld as alleged, such modification still would not have resulted in the apparatus having the recited features and relationships. The resulting modified LA Times system still would not teach or suggest the recited features of an automated transaction machine that is responsive to a document accessed by a browser to provide an output through an output device, especially during operation of a currency sheet dispenser of the machine.

Even if it were somehow possible to modify the system of LA Times (1994) with the teaching of Infoworld, it would have at best resulted in use of the Top End monitoring program with regard to an ATM. However, Infoworld (beginning in July 1996) already teaches use of Top End with regard to an ATM. Thus, modification (if somehow possible) of LA Times with the teachings of Infoworld would not have produced the recited invention. Thus, it would not



have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of Infoworld to have produced the recited invention.

As previously discussed, none of the relied upon references even teach or suggest an automated transaction machine currency sheet dispenser. It follows that neither LA Times nor Infoworld, taken alone or in combination, teach or suggest an automated transaction machine that during operation of a currency sheet dispenser, can provide an output through an output device, responsive to a document accessed by a browser. The references, taken alone or in combination, do not teach or suggest the recited features of an output device, currency sheet dispenser, computer, software, and browser of an automated transaction machine. Nor do the references, taken alone or in combination, teach or suggest the recited relationships between these features. Not all of the recited features and relationships are taught or suggested by the applied references. However, to establish *prima facie* obviousness, it must be shown that all features and relationships recited in the claim are known in the prior art. Thus, the Office has not established a *prima facie* case of obviousness. Appellants respectfully submit that the deficient nature of the references, and the lack of supporting evidence of record with regard to the Official notices, renders the rejection invalid.

The attempts to combine the alleged teachings are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Appellants' disclosure.

As previously discussed, neither of the relied upon references, taken alone or in combination, disclose or suggest the features and relationships that are specifically recited in claim 1. Thus, a *prima facie* case of obviousness has not been established. Furthermore, as previously discussed, it would not have been obvious to one having ordinary skill in the art to have combined the references as alleged. The applied prior art is devoid of any such teaching, suggestion, or motivation for combining features of the references so as to produce the recited invention. Nevertheless, as previously discussed, even if it were somehow possible for the references to be combined as alleged, the resultant combination still would not have resulted in the claimed invention. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be withdrawn.

## **Claim 2**

Appellants' remarks in support of the patentability of claim 1 are incorporated by reference as if fully rewritten herein. Claim 2 recites some subject matter similar to subject matter in claim 1. As previously discussed, the references do not teach or suggest the commonly recited features and relationships. Claim 2 also recites that the browser can process an accessed document having instructions to provide the output through the output device and cause the computer to operate a sheet dispenser. Furthermore, it is recited that the software is operative to provide the output during operation of the sheet dispenser.

Neither LA Times nor Infoworld, taken alone or in combination, teach or suggest the recited features and relationships. Where does either reference teach or suggest the ability of an automated transaction machine to process instructions of a browser-accessed document to provide an output through an output device? Where does either reference teach or suggest the

ability of an automated transaction machine to also process instructions of the browser-accessed document to cause a computer to operate a sheet dispenser? Where does either reference teach or suggest automated transaction machine software that is operative to process a document to both provide an output and dispense a sheet, especially where the output is provided during the dispense of the sheet. Where do the references correlate dispensing and outputting? The applied references do not teach or suggest the recited automated transaction machine features or the relationships thereof.

The Action has not established a *prima facie* showing of obviousness. Neither of the references, taken alone or in combination, teach or suggest all of the recited features and relationships, as is required to sustain the rejection. As previously discussed, the Official notice allegations lack substantial evidence support of record. Modification of LA Times with the teachings of Infoworld as alleged would not have resulted in the recited invention. Nor would it have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of Infoworld to have produced the recited invention. Appellants respectfully request that the 35 U.S.C. § 103(a) rejection be withdrawn.

### **Claim 3**

Claim 3 depends from claim 1 and further recites that the document comprises an HTML document. The browser is operative to access the HTML document through a server. The HTML document is associated with providing an output through an output device during operation of a currency sheet dispenser.

As previously discussed, neither LA Times nor Infoworld, taken alone or in combination, teach or suggest an automated transaction machine that is responsive to a document accessed by

a browser to provide an output through an output device. It follows that neither reference taken alone or in combination, teaches or suggests an automated transaction machine that is responsive to an HTML document accessed by a browser (through a server) to provide an output through an output device, especially during operation of a currency sheet dispenser of the machine. Furthermore, as previously discussed, the Action is silent as to any prior art teaching or suggestion whatsoever of automated transaction machine software with the capability to provide an output through an output device during operation of a currency sheet dispenser.

The Action has not established a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of Infoworld to have produced the recited invention.

#### **Claim 4**

Appellants' remarks in support of the patentability of claims 1 and 2 are incorporated by reference as if fully rewritten herein. As previously discussed, the applied references do not teach or suggest the recited features and relationships which are found in claims 1 and 2, as well as in claim 4. Claim 4 further recites a server and plural documents accessible through the server, including a first document and a dispense document (including a dispense instruction). Claim 4 also recites that an automated transaction machine is operative responsive to processing the dispense document to operate a sheet dispenser (responsive to the dispense instruction) and to access a first document (responsive to the dispense instruction).

Neither LA Times nor Infoworld, taken alone or in combination, teach or suggest the recited features and relationships. Neither reference, taken alone or in combination, teach or suggest processing an accessed dispense document (that includes a dispense instruction) to

operate a sheet dispenser responsive to the dispense instruction. Neither reference, taken alone or in combination, teach or suggest processing an accessed dispense document (including a dispense instruction) and further accessing another document responsive to the dispense instruction. That is, neither reference teaches or suggests accessing a first document responsive to processing a dispense instruction in a dispense document. It follows that neither reference, taken alone or in combination, can teach or suggest the ability to both operate a sheet dispenser and access a first document responsive to processing an accessed dispense document including a dispense instruction.

The Action has not established a *prima facie* showing of obviousness. Neither of the references, taken alone or in combination, teach or suggest all of the recited features and relationships. Furthermore, as previously discussed, the Official notice allegations lack substantial evidence support of record. Thus, alleged modification of LA Times with the teachings of Infoworld would not have resulted in the recited invention. It follows that it would not have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of Infoworld to have produced the recited invention. Appellants respectfully request that the 35 U.S.C. § 103(a) rejection be withdrawn.

#### **Claim 5**

Claim 5 depends from claim 4. The Action is silent regarding the recited features and relationships in claim 5. Nevertheless, neither of the applied references, taken alone or in combination, teach or suggest that a computer is operative responsive to processing an additional device document (including an additional device instruction) to operate an additional transaction

function device and to access a second document responsive to the additional device document. It follows that the Office has not established a *prima facie* showing of obviousness.

#### **Claim 6**

Claim 6 depends from claim 4. Claim 6 further recites that the dispense document includes a document access instruction, and that the browser is capable of processing the first document responsive to the document access instruction. The Action is silent regarding the recited features. Neither of the applied references, taken alone or in combination, teach or suggest the recited relationship between a dispense document and a first document. The Office has not made a *prima facie* showing of obviousness.

#### **Claim 7**

Appellants' remarks in support of the patentability of claims 1 and 2 are incorporated by reference as if fully rewritten herein. Claim 7 is directed to a method comprising accessing a transaction device operation document (including at least one transaction device instruction) with a browser in an automated transaction machine, and automatically operating a transaction device and automatically outputting an output responsive to processing the document with the browser.

Neither LA Times nor Infoworld, taken alone or in combination, teach or suggest a transaction device operation document including at least one transaction device instruction. Neither reference, taken alone or in combination, teach or suggest accessing a transaction device operation document with a browser in an automated transaction machine. Neither reference relates operating a transaction device to processing of the accessed transaction device operation document. Neither reference relates outputting an output to processing of the accessed transaction device operation document. Nor has the Action indicated what in the applied

references allegedly constitutes the recited transaction device and what constitutes the recited output device. It follows that neither reference, taken alone or in combination, teach or suggest automatically operating a transaction device and automatically outputting with an output device responsive to processing the transaction device operation document.

Neither LA Times nor Infoworld, taken alone or in combination, teach or suggest the recited features, relationships, and steps. As previously discussed, the Official notice allegations lack substantial evidence support of record. The Action has not established a *prima facie* showing of obviousness. Nor would the alleged modification have resulted in the recited invention. It would not have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of Infoworld to have produced the recited invention. Appellants respectfully request that the 35 U.S.C. § 103(a) rejection be withdrawn.

#### **Claim 8**

Claim 8 depends from claim 7. The Action is silent regarding the recited step. Neither of the applied references, taken alone or in combination, teach or suggest accessing a first document responsive to processing a transaction device operation document, and having an output generated responsive to processing the first document. Again, the Office has not established a *prima facie* showing of obviousness.

#### **Claim 9**

Claim 9 depends from claim 8/7. The Action is silent regarding the recited steps. Neither of the applied references, taken alone or in combination, teach or suggest that a transaction device operation document (which includes a transaction device instruction) is operative to cause the operation of a transaction function device. Nor do the references teach or suggest operating a

second transaction function device in a machine responsive to accessing a further transaction machine document. Nor do the references teach or suggest accessing a second document responsive to receipt of the further transaction machine operation document, and outputting a further output responsive to processing the second document. The Office has not established a *prima facie* showing of obviousness.

#### **Claim 10**

Claim 10 depends from claim 7. Neither of the applied references, taken alone or in combination, teach or suggest an output including a promotional message. The Action (on page 5) alleges that Bank indicia on a receipt and a bank statement dispensed from a "typical" ATM are promotional messages. The Appellants respectfully disagree.

As previously discussed (e.g., claim 1 remarks), the Action has not established what in the prior art constitutes the alleged "typical ATM." Nor is there any teaching or suggestion that the relied upon ATM is "a typical ATM. Contrarily, as previously discussed, LA Times teaches a "specially designed" (i.e., atypical) ATM. Nor has the Office provided any evidence of record that each prior art "typical" ATM required the capability to dispense a receipt and a bank statement.

Nor has the Action provided any prior art evidence of record of bank indicia being on an ATM receipt or on an ATM bank statement. Nor has the Action shown that prior art bank indicia (on a receipt or bank statement) constituted a promotional message. Where is the alleged prior art showing of a receipt and a bank statement having bank indicia that is promotional? Where is the alleged prior art showing of a receipt and a bank statement having bank indicia that is a message? The allegation lacks substantial evidence support of record. *In re Zurko*, supra.



Furthermore, the Action has not presented one iota of evidence of an ATM dispensing either a receipt or a bank statement (with or without bank indicia thereon) responsive to processing a document (having an instruction) with a browser. Nor has the Action indicated whether the alleged receipt or bank statement dispenser would constitute the recited transaction device or the recited output device. The Action procedurally fails to establish a *prima facie* case of obviousness.

#### **Claim 11**

Claim 11 depends from claim 9/8/7. Neither of the applied references, taken alone or in combination, teach or suggest the recited output includes a first promotional message and the recited further output includes a second promotional message. Appellants' remarks regarding a "promotional message" in support of the patentability of claim 10 are incorporated by reference as if fully rewritten herein. As previously discussed neither of the applied references, taken alone or in combination, teach or suggest an output including a promotional message. It follows that the Office has not established a *prima facie* case of obviousness.

#### **Claim 12**

Claim 12 depends from claim 8/7. Neither of the applied references, taken alone or in combination, teach or suggest determining an address of a first document to access responsive to inputted user data. Neither of the applied references correlate determining a document address to input user data (which corresponds to a user).

The Action (on page 5) alleges that a typical ATM requires an ATM card to access the user's bank account. The allegation lacks substantial evidence support of record. *In re Zurko*, supra. As previously discussed (e.g., claim 1 remarks), LA Times teaches a "specially designed"

(i.e., atypical) ATM. Nor has the Office provided any evidence of record that the asserted prior art "typical" ATM required an ATM card. Nor is there any teaching or suggestion that the LA Times (Citibank) ATM has or needs a browser. Even if it were somehow possible for the Citibank ATM to have a browser, there would still be no teaching or suggestion that the browser "would open web pages related to the user, the web pages having previously determined addresses and performing different transactional and informational functions as required by the user" as alleged. Regardless, even if it were somehow possible for the Citibank ATM to have a browser, there would still be no teaching or suggestion of determining an address of a document to access responsive to input user data.

The Office has not established a *prima facie* case of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of Infoworld as alleged to have produced the recited invention.

### **Claim 13**

Appellants' remarks in support of the patentability of claims 1, 2 and 7 are incorporated by reference as if fully rewritten herein. Claim 13 is directed to a method including executing a series of transaction steps with an automated transaction machine, wherein between at least two consecutive transaction steps a device in the machine automatically operates in response to an accessed document, and automatically providing an output through an output device on the machine responsive to an accessed document during at least a portion of the device operation.

Neither LA Times nor Infoworld, taken alone or in combination, teach or suggest that between at least two consecutive transaction steps, a device in an automated transaction machine automatically operates in response to an accessed document. As previously discussed, neither

reference even relates operation of an automated transaction machine device to an accessed document. Nor do the references teach or suggest automatically providing an output through an output device on the machine responsive to an accessed document during at least a portion of the device operation. As previously discussed, neither reference even relates automated transaction machine output to an accessed document. It follows that neither of the references, taken alone or in combination, teach or suggest all of the features, relationships, and steps. Furthermore, as previously discussed, the Official notice allegations lack substantial evidence support of record.

Thus, the Action has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of either Infoworld or Anderson to have produced the recited invention. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be withdrawn.

#### **Claim 14**

Claim 14 depends from claim 13. The Action is silent regarding the recited steps. Neither of the applied references, taken alone or in combination, teach or suggest a request to dispense a currency sheet. Nor do the references teach or suggest automatically providing an output through an output device on an automated transaction machine (responsive to an accessed document) during at least a portion of the time a currency sheet dispenser device operates. It follows that the Office has not established a *prima facie* showing of obviousness.

#### **Claim 15**

Claim 15 depends from claim 1. Appellants' remarks regarding a "promotional message" in support of the patentability of claim 10 are incorporated by reference as if fully rewritten herein. As previously discussed, neither of the applied references, taken alone or in combination,

teach or suggest an output including a promotional message. It follows that neither LA Times nor Infoworld teach or suggest outputting a promotional message responsive to an accessed document during operation of a currency sheet dispenser. The Office has not established a *prima facie* case of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of Infoworld to have produced the recited invention.

#### **Claim 16**

Claim 16 depends from claim 7. As previously discussed, neither of the applied references, taken alone or in combination, teach or suggest a currency note dispenser device. The Action's allegation (on page 5) that all (prior art) ATM's have a currency note dispenser device lacks substantial evidence support of record. *In re Zurko*, supra. Nevertheless, neither LA Times nor Infoworld teach or suggest automatically operating a currency note dispenser device responsive to processing a transaction device operation document with a browser. Thus, the Office has not established a *prima facie* showing of obviousness.

#### **Claim 17**

Claim 17 depends from claim 7. Neither of the applied references, taken alone or in combination, teach or suggest automatically outputting an output and automatically operating a transaction device, responsive to processing a transaction device operation document. It follows that the applied references cannot teach or suggest that the outputting step occurs during at least a portion of the operating step. It further follows that it would not have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of Infoworld to

have produced the recited invention. The Office has not established a *prima facie* showing of obviousness.

**Claim 18**

Claim 18 depends from claim 13. Appellants' remarks regarding a "promotional message" in support of the patentability of claim 10 are incorporated by reference as if fully rewritten herein. As previously discussed, neither of the applied references, taken alone or in combination, teach or suggest an output including a promotional message. It follows that neither LA Times nor Infoworld teach or suggest outputting a promotional message (responsive to an accessed document) during at least a portion of the device operation. The Office has not established a *prima facie* case of obviousness.

**Claim 19**

Claim 19 depends from claim 13. Claim 19 further recites that the device includes a currency note dispenser device operative to dispense at least one currency note, and the output device includes a display device. The Action's allegation (on page 5) that all (prior art) ATM's have a display device and a currency note dispenser device lacks substantial evidence support of record. *In re Zurko*, supra.

Nevertheless, as previously discussed, neither LA Times nor Infoworld, taken alone or in combination, teach or suggest a currency note dispenser device. Further, neither of the applied references teach or suggest that between at least two consecutive transaction steps, a currency note dispenser device in an automated transaction machine automatically operates in response to an accessed document. Nor do the applied references teach or suggest automatically providing an output through a display device on the machine (responsive to an accessed document) during

at least a portion of a currency note dispenser device operation. Thus, the Office has not established a *prima facie* showing of obviousness.

**Claim 20**

Claim 20 depends from claim 13. Claim 20 further recites that the document accessed in step (b) differs from the document accessed in step (c). Neither LA Times nor Infoworld, taken alone or in combination, teach or suggest automatically providing an output through an output device on an automated transaction machine (responsive to an accessed document) during at least a portion of a device operating (in response to another accessed document), especially where the documents differ. Again, the Office has not established a *prima facie* case of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of Infoworld to have produced the recited invention.

**CONCLUSION**

Each of Appellants' claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any teaching, suggestion, or motivation for combining features of the applied art so as to produce the recited invention. For these reasons it is respectfully submitted that all the claims are allowable.

Respectfully submitted,



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## APPENDIX

### CLAIMS

1. Apparatus comprising:

an automated transaction machine including:

an output device;

a currency sheet dispenser;

a computer in operative connection with the output device and the  
currency sheet dispenser; and

software executable in the computer, wherein the software includes a  
browser, and wherein during operation of the currency sheet dispenser the  
software is operative to provide an output through the output device  
responsive to a document accessed by the browser.

2. Apparatus comprising:

an automated transaction machine including:

an output device;

a sheet dispenser;

a computer in operative connection with the output device and the sheet dispenser;

software executable in the computer, wherein the software includes a browser, and wherein during operation of the sheet dispenser the software is operative to provide an output through the output device responsive to a first document accessed by the browser;

wherein the first document includes instructions which are operative when processed by the browser to provide the output through the output device, and to cause the computer to operate the sheet dispenser to dispense a sheet.

3. The apparatus according to claim 1 and further comprising:

at least one server;



a plurality of HTML documents accessible through the server, wherein the document comprises a first HTML document and is accessible through the server; and

wherein the browser is operative to access the first HTML document through the server.

4. Apparatus comprising:

at least one server;

a plurality of documents accessible through the server, wherein a first document is accessible through the server;

an automated transaction machine including:

an output device;

a sheet dispenser;

a computer in operative connection with the output device and the sheet dispenser;

software executable in the computer, wherein the software includes a browser, wherein the browser is operative to access the first document through the server, and wherein during operation of the sheet dispenser the software is operative to provide an output through the output device responsive to the first document accessed by the browser;

wherein the documents accessible through the at least one server includes a dispense document including a dispense instruction, and wherein the computer is operative responsive to processing the dispense document with the browser to operate the sheet dispenser responsive to the dispense instruction, and wherein the machine is operative to access the first document with the browser responsive to the dispense instruction.

5. The apparatus according to claim 4 wherein the machine comprises at least one additional transaction function device, and wherein the plurality of documents accessible through the at least one server includes an additional device document, wherein the additional device document includes an additional device instruction, and wherein the plurality of documents further includes a second document, and wherein the computer is operative responsive to processing the additional device document with the browser to operate the additional transaction function device responsive to the additional device instruction, and wherein the computer is operative to access the second document with the browser responsive to the additional device document.

6. The apparatus according to claim 4 wherein the dispense document includes a first document access instruction, and wherein the browser processes the first document responsive to the first document access instruction.

7. A method comprising the steps of:

accessing a transaction device operation document with a browser in an automated transaction machine, the transaction device operation document including at least one transaction device instruction;

automatically operating a transaction device in the machine responsive to processing the transaction device operation document with the browser; and

automatically outputting with an output device on the machine an output responsive to processing the transaction device operation document with the browser.

8. The method according to claim 7 and further comprising the step of:

accessing a first document with the browser responsive to processing the transaction device operation document accessed in the accessing step, wherein in

the outputting step the output is generated responsive to processing the first document by the browser.

9. The method according to claim 8 wherein the transaction machine includes a first transaction function device and a second transaction function device, and wherein a transaction device operation document is operative to cause the operation of the first transaction function device in the operating step, and further comprising the steps of:

further accessing a further transaction machine operation document with the browser;

further operating the second transaction function device in the machine responsive to accessing the further transaction machine document with the browser;

further accessing a second document with the browser responsive to receipt of the further transaction machine operation document; and

further outputting a further output with the output device of the machine responsive to processing the second document with the browser.

10. The method according to claim 7 wherein the output includes a promotional message.

11. The method according to claim 9 wherein the output includes a first promotional message and the further output includes a second promotional message.

12. The method according to claim 8 and prior to the accessing step further comprising the steps of:

inputting user data corresponding to a first user into an input device of the automated transaction machine;

and prior to the step of accessing the first document, further comprising the step of determining an address of a first document to access responsive to the user data input in the inputting step.

13. A method comprising the steps of:

a) accessing at least one document with a browser in an automated transaction machine;

b) executing a series of transaction steps with an automated transaction machine wherein between at least two consecutive transaction steps a device in the machine automatically operates in response to an accessed document;

c) automatically providing an output through an output device on the machine responsive to an accessed document during at least a portion of the device operation.

14. The method according to claim 13 wherein step (b) includes a transaction step including a request to dispense at least one currency sheet, wherein a currency sheet dispenser device operates responsive to the request transaction step, and wherein output in step (c) is provided during at least a portion of the time the currency sheet dispenser device operates.

15. The apparatus according to claim 1 wherein the output includes a promotional message.

16. The method according to claim 7 wherein the transaction device includes a currency note dispenser device operative to dispense at least one currency note.

17. The method according to claim 7 wherein the outputting step occurs during at least a portion of the operating step.

18. The method according to claim 13 wherein the output includes a promotional message.

19. The method according to claim 13 wherein the device includes a currency note dispenser device operative to dispense at least one currency note, and the output device includes a display device.

20. The method according to claim 13 wherein the document accessed in step (b) differs from the document accessed in step (c).